

REMARKS

Claims 1, 2, 4 through 7 and 10 through 14 are pending in this Application, of which claims 11 through 14 stand withdrawn from consideration pursuant to the provisions of 37 C.F.R. § 1.142(b). Applicants acknowledge, with appreciation, the Examiner's allowance of claims 7 and 10. Applicants also acknowledge, with appreciation, the Examiner's indication that claims 4 through 6 contain allowable subject matter. Accordingly, the only remaining issue pivots about the patentability of claims 1 and 2.

Claim 1 has been amended by incorporating the limitations of claim 3 therein, and claim 3 cancelled. Claim 1 has been further amended to clarify that the niobium nitride layer is in direct contact with the niobium particles. In addition, claims 15 and 16 have been cancelled. Care has been exercised to avoid the introduction of new matter issue. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure noting the illustrated embodiments and related discussion thereof in the written description of the specification. Applicants submit that the present Amendment does not generate any new matter issue.

Claim 1 was rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Yoshida et al.

In the statement of the rejection the Examiner referred to Figs. 4 and 6 of Yoshida et al., asserting the disclosure of a capacitor corresponding to that claimed and identifying substrate 13, niobium nitride layer 22 and niobium oxide layer 16. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art.

Dayco Prods., Inc. v. Total Containment, Inc., 329 F.3d 1358, 66 USPQ2d 1801 (*Fed. Cir.* 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (*Fed. Cir.* 2002). There are significant differences between the claimed capacitor and the capacitor disclosed by Yoshida et al. that scotch the factual determination that Yoshida et al. disclose a capacitor identically corresponding to that claimed.

Initially, this rejection has been rendered moot by incorporating the limitations of claim 3 into claim 1, claim 3 not being subject to this rejection. Moreover, claim 1 further distinguishes over Yoshida et al. by specifying that the niobium nitride layer is in direct contact with the niobium particles. No such structure is disclosed or suggested by Yoshida et al.

Indeed, advertizing to Fig. 4 of Yoshida et al., it should be apparent that niobium nitride layer 15 is not in direct contact with substrate 13. Rather, nitride layer 15 is embedded within oxide layer 16.

Applicants would note that Fig. 6 of Yoshida et al. does not cure the above argued deficiencies in Fig. 4 of Yoshida et al. Applicants acknowledge that in column 4, lines 15 through 18, it is disclosed that nitride layer 22 was formed on the surface of niobium metal 21 of anode 20. However, Fig. 6 merely shows a stage in the process of fabrication. The **final fabricated capacitor** is illustrated in Fig. 4 and in Fig. 4, as pointed out above, there is no niobium nitride layer formed in direct contact with niobium particles. Further, as specified now in claim 1, the dielectric layer is nitrogen-free. As recognized by the Examiner, Yoshida et al. neither disclose nor suggest a solid electrolytic capacitor as claimed, wherein the dielectric nitride layer is nitrogen-free.

The above argued differences between the claimed solid electrolytic capacitor and that disclosed by Yoshida et al. undermine the factual determination that Yoshida et al. disclose a

solid electrolytic capacitor identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claim 1 under 35 U.S.C. § 102 for lack of novelty as evidenced by Yoshida et al. is not factually viable and, hence, solicit withdrawal thereof.

Claims 1 through 3, 15 and 16 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Yuan.

This rejection is traversed. Specifically, the present Application claims priority to an application filed on March 28, 2003. Applicants submit herewith as Exhibit A a certified English language translation of the foreign priority document, thereby antedating the effective date of Yuan which Applicants is no earlier than July 28, 2003, assuming the provisional application provides the requisite support under 35 U.S.C. §112. Accordingly, withdrawal of the rejection of claims 1 through 3, 15 and 16 under 35 U.S.C. § 102 for lack of novelty as evidenced by Yuan is solicited.

Claims 15 and 16 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Masuda et al. in view of Shimada et al. and Tripp et al.

This rejection has been rendered moot by canceling claims 15 and 16.

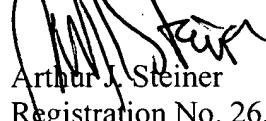
Applicants again acknowledge, with appreciation, the Examiner's allowance of claims 7 and 10, and the Examiner's indication that claims 4, 5 and 6 contain allowable subject matter.

Based upon the foregoing it should be apparent that the imposed rejections have been overcome and that all active claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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